

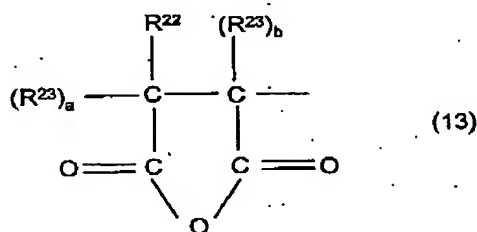
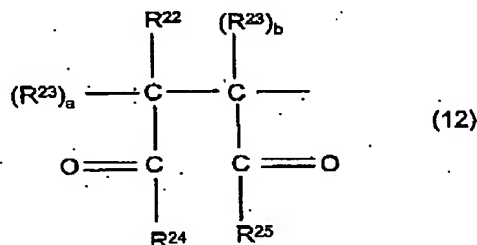
Attorney's Docket: 2000DE441D  
Serial No.: 10/808,095  
Art Unit: 1712  
Response to Office Action, Dated 12/27/2005

### REMARKS

The Office Action mailed December 27, 2005 has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks is respectfully requested.

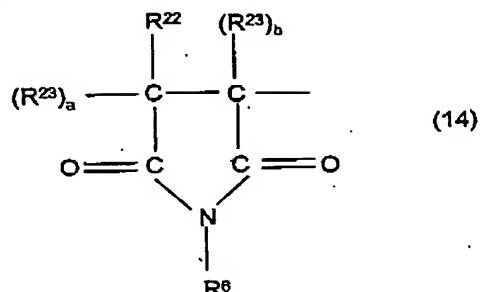
Applicant has amended the Application to attend to housekeeping matters and to more clearly describe the invention. Applicant has amended claims 7, 10 and 11 to recite that the at least one polar nitrogen-containing compound B) is a terpolymer comprising:

- 1) 20 – 80 mol% of a divalent structural unit selected from the group consisting of formula 12, 14, 13, and mixtures thereof,



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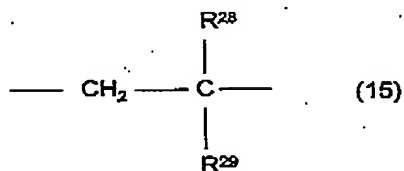
where

$R^{22}$  and  $R^{23}$ , independently of one another, are hydrogen or methyl,

$a$  and  $b$  are zero or one and  $a + b$  is one,

$R^{24}$  and  $R^{25}$  are identical or different and are  $-NHR^6$ ,  $N(R^6)_2$  or  $-OR^{27}$  or a combination thereof, and  $R^{27}$  is a cation of the formula  $H_2N(R^6)_2$  or  $H_3NR^6$ ,

II) 19 - 80 mol% of a divalent structural unit of formula 15



in which

$R^{28}$  is hydrogen or  $C_1$ - $C_4$ -alkyl, and

$R^{29}$  is  $C_6$ - $C_{60}$ -alkyl or  $C_6$ - $C_{18}$ -aryl, and

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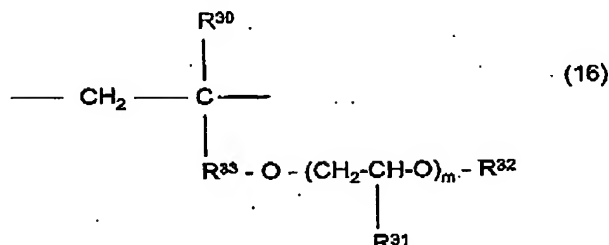
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III) 1 - 30 mol% of a divalent structural unit of formula 16



in which

R<sup>30</sup> is hydrogen or methyl,

R<sup>31</sup> is hydrogen or C<sub>1</sub>-C<sub>4</sub>-alkyl,

R<sup>33</sup> is C<sub>1</sub>-C<sub>4</sub>-alkylene,

m is a number from 1 to 100,

R<sup>32</sup> is C<sub>1</sub>-C<sub>24</sub>-alkyl, C<sub>5</sub>-C<sub>20</sub>-cycloalkyl, C<sub>6</sub>-C<sub>18</sub>-aryl or -C(O)-R<sup>34</sup>,

where R<sup>34</sup> is C<sub>1</sub>-C<sub>40</sub>-alkyl, C<sub>5</sub>-C<sub>10</sub>-cycloalkyl or C<sub>6</sub>-C<sub>18</sub>-aryl. Support for the amendments to claims 7, 10 and 11 may be found in Applicant's Specification in paragraph number [0059] (See pages 18 - 20). Claim 16 was amended to recite that the carboxylic acid is a mono or dicarboxylic acid. Support for the amendment to claim 16 may be found in originally filed claim 1. It is believed that no new matter has been introduced by these amendments.

Claim 16 was rejected under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject which Applicant regards as the invention. The rejection of claim 16, as amended, under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject which Applicant regards as the invention, should be withdrawn in view of the above amendment which now clearly recites that the carboxylic acids referred to are mono- and dicarboxylic acids as recited in claim 1, from which claim 16 depends.

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Claims 7, 10-13 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP 11001692. The rejection of claim 7 as amended under 35 U.S.C. §103(a) as being unpatentable over JP 11001692 should be withdrawn for the reason that the JP 11001692 does not disclose the terpolymer polar nitrogen-containing compound claimed by the applicant and no one skilled in the art would be motivated to employ Applicant's terpolymer based solely on the JP 11001692 disclosure. The JP reference discloses that nitrogen-containing amides and salts thereof can be combined with fatty acid mixtures. The JP reference is silent on the use of any terpolymers as nitrogen-containing compounds for the improvement of the properties of low sulfur fuel oils. Obvious to try is not the standard of 35 USC 103. The prior art references must be read as a whole and consideration must be given where the reference diverge and teach away from the claimed invention. No one skilled in the art would be able to combine any of the teachings of the reference to render the instant invention obvious without the improper use of hindsight. The rejection of claim 7 as amended under 35 U.S.C. §103(a) as being unpatentable over JP 11001692 should be withdrawn for the reason that the JP 11001692 reference teaches away from applicant's invention and no one skilled in the art armed with the JP 11001692 reference would be motivated to arrive at applicant's invention. The rejection of claims 10-13 and 15 as amended under 35 U.S.C. §103(a) as being unpatentable over JP 11001692 should be withdrawn for the reasons given in support of claim 7.

Claims 7, 12 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over WO 0015739 in view of Weers (US 6,129,772). The rejection of claim 7 as amended under 35 U.S.C. §103(a) as being unpatentable over WO 0015739 in view of Weers (US 6,129,772) should be withdrawn for the reason that reason that WO 0015739 teaches away from applicant's invention and no one skilled in the art armed with the WO 0015739 reference, even combined with the '772 patent would be motivated to arrive at applicant's invention. The WO reference relates to a diesel fuel composition containing an additive composition made by admixing at least two components: a) at least one dicarboxylic acid having about 8 to about 500 carbon atoms or a reactive equivalent thereof; and b) at least one amine

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having about 6 to about 80 carbon atoms. Nowhere in the WO reference is a polar nitrogen compound disclosed which is a terpolymer of the 3 structural units disclosed and claimed by the Applicant. The Weers reference appears to be relied on only to show that fuel oil additives can be prepared in aromatic and paraffinic solvents. No combination of either the WO reference or the Weers reference will produce Applicant's claimed invention. Obvious to try is not the standard of 35 USC 103. The prior art references must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention. No one skilled in the art would be able to combine any of the teachings of the references to render the instant invention obvious without the improper use of hindsight. Therefore, the rejection of claim 7 as amended under 35 U.S.C.103(a) as being unpatentable over WO 0015739 in view of Weers (US 6,129,772) should be withdrawn for the reason that WO 0015739 teaches away from applicant's invention and no one skilled in the art armed with the WO 0015739 reference, even combined with the '772 patent would be motivated to arrive at applicant's invention. The rejection of claims 12 and 17 as amended under 35 U.S.C.103(a) as being unpatentable over WO 0015739 in view of Weers (US 6,129,772) should be withdrawn for the reasons given in support of claim 7 from which they depend.

Claims 10, 11, 13, 15 and 16 were rejected under 35 U.S.C 103(a) as being unpatentable over WO 0015739. The rejection of claim 10, as amended under 35 U.S.C 103(a) as being unpatentable over WO 0015739 should be withdrawn for the reason that as discussed hereinabove, nowhere in the WO0015739 reference is a polar nitrogen compound disclosed which is a terpolymer of the 3 structural units disclosed and claimed by the Applicant. Obvious to try is not the standard of 35 USC 103. The prior art references must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention. No one skilled in the art would be able to combine any of the teachings of the references to render the instant invention obvious without the improper use of hindsight. Therefore, the rejection of claim 10 as amended under 35 U.S.C.103(a) as being unpatentable over WO 0015739 should be withdrawn for the reason that WO 0015739 teaches away from applicant's invention and no one skilled in the art armed

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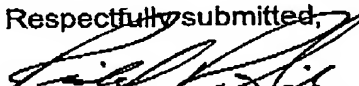
with the WO 0015739 reference, would be motivated to arrive at applicant's invention. The rejection of claims 111, 13, 15 and 16, as amended, under 35 U.S.C.103(a) as being unpatentable over WO 0015739 should be withdrawn for the reasons given hereinabove in support of claim 10.

Claims 7 and 10-17 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of US Patent 6,610,111 in view of Weers (US 6,129,772) Applicant has herewith provided a Terminal Disclaimer which disclaims the terminal portion of the statutory term of any patent granted on the instant invention which would extend beyond the expiration date of the full statutory term of US Patent 6,610,111, which is commonly owned and the extent of which is the whole of this invention. Therefore the provisional rejection of Claims 7 and 10-17 under the judicially created doctrine of double patenting over the claims of US Patent 6,610,111 should be withdrawn.

Claim 7 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 as originally filed of copending Application No. 10/938,495. Applicant has herewith provided a Terminal Disclaimer which disclaims the terminal portion of the statutory term of any patent granted on the instant invention which would extend beyond the expiration date of the full statutory term of any patent granted on copending Application No. 10/938,495, which is commonly owned and the extent of which is the whole of this invention. Therefore the provisional rejection of Claim 10 under the judicially created doctrine of double patenting over claim 7 of copending Application No. 10/938,495 should be withdrawn.

An early and favorable action on the merits is respectfully requested. The Commissioner is hereby authorized to charge any fee deficiency to Deposit Account No. 03-2060.

Respectfully submitted,

  
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